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Jason A Reyes
Hale and Dorr LLP
60 State Street
Boston, MA 02109

EXAMINER

ALLEN, MARIANNE P

ART UNIT PAPER NUMBER

1631

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,810

Applicant(s)

BRECHER, JONATHAN S.

Examiner

Marianne P. Allen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 51-72 are under consideration by the examiner.

Applicant's arguments filed 1/13/2005 have been fully considered but they are not persuasive.

The rejection of claims 51-72 under 35 U.S.C. 102(b) as being anticipated by Boyer et al. (U.S. Patent No. 5,345,516) is withdrawn in view of applicant's arguments.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

Claims 51-72 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a new matter rejection.

This rejection is maintained for reasons of record and further explained below.

Claims 51-72 are not originally filed claims and differ significantly from the originally filed claims. Pages 11-14 of the response outlines where applicant believes basis for claims 51-72 is found. Applicant argues that nowhere in the specification, figures or originally filed claims were any steps disclosed as being essential and that the figures and as-filed claims clearly indicate an intention to claim a generic method. Applicant argues that they contemplated embodiments varying in scope between Figure 2 and Figures 3A-B. Applicant does not wish to be limited to particular embodiments of the method as disclosed for example in the Figures.

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Applicant's arguments are not agreed with. Applicant may desire claims that vary in scope between the original claims and specific embodiments in the figures and disclosure, but this does not mean that the present claims were contemplated in the originally filed specification.

A fair reading of the originally filed specification, including the drawings and originally filed claims, would not convey to one of ordinary skill in the art that the methods of claims 51 and 54 and computer software of claims 63 and 65 were contemplated. Applicant may not arbitrarily pick and choose method steps disclosed in the specification and arrive at a method that was not contemplated, particularly where the steps as written in the claims are broad and the particular disclosure relied upon is not.

The method as disclosed in the specification is described with respect to Figures 3A-B and Figure 4. However, the claimed method steps do not even correspond to these figures.

Note that page 13, line 16, indicates that the name is divided into the smallest number of meaningful fragments of a maximum length. This is not recited in the claims.

At least claims 51, 54, and 62 recite "associating each text string fragment with at least one data object known as a nomToken." The specification at page 14, lines 1-2, is discussing "known text strings" not any text strings. That is, the preceding and following text disclose this association in the context of matches in a lexicon or dictionary of known text strings. That is, determination of Types, Subtypes, etc. are not contemplated for unknown text strings such as "penta," "n" and "e" for the acquired chemical name "pentane." See page 13.

Likewise, the specification does not contemplate dividing the name "Phenacyl bromide, p-napthoxy" into a series of text string fragments without first preprocessing it to standardize its formatting.

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At least claims 51 and 62 recite “consolidating the list of nomTokens into a smaller list.” This does not reflect the concept contemplated in the specification on page 18 that the list of nomTokens is examined sequentially to determine whether adjacent nomToken names could be concatenated. This does not reflect the concept contemplated in the specification on page 20 that two or more nomTokens are joined into a single replacement nomToken.

The concepts of “classified by Type and Subtype” (claims 51, 62, and 65) and “initially identified as the nomToken of highest Type and Subtype” (claim 54) does not set forth the concept that a nomToken record includes data objects for Type and Subtype with of some value that can be ranked in some way.

Claims 51-72 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This is an enablement rejection.

This rejection is maintained for reasons of record.

Applicant is requested to explain how the method of the claims as presently written would derive the chemical structure for the acquired chemical name “Phenacyl bromide, p-naphthoxy” in the absence of preprocessing.

Applicant is requested to explain how the method of the claims as presently written would derive the chemical structure for the acquired chemical name “pentane” that has been broken into the ext strings “penta,” “n” and “e.”

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Applicant's arguments are unpersuasive. The guidelines in the specification at pages 19-20 are not limitations of the claims. In addition, the example on pages 21-22 does not provide sufficient guidance or information to extrapolate to other environments and determinations of compatability or lack thereof.

It is maintained that the specification provides a specific example of a "locant map," an "attach-in map," and an "attach-out map." There is no disclosure of the metes and bounds of all such data objects that are intended to be encompassed by these terms nor guidance on how to make or use them. The art of record and in the specification do not demonstrate that these are well known and routinely used maps in the area of chemical structural derivation.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 571-272-0712. The examiner can normally be reached on Monday-Thursday, 5:30 am - 1:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Marianne P. Allen

Marianne P. Allen
Primary Examiner
Art Unit 1631

4/18/05

mpa